

BEST AVAILABLE COPY



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/323,636 06/01/99 BARRY

J 8688,6808

EXAMINER

MM92/0705

DANIEL S POLLEY ESQ
MALIN HALEY & DIMAGGIO
1936 SOUTH ANDREWS AVENUE
FORT LAUDERDALE FL 33316

LEE, Y

ART UNIT

PAPER NUMBER

2875

DATE MAILED:

07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/323,636

Applicant(s)

JAMES E. BARRY

Examiner

Y QUACH LEE

Group Art Unit

2875

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 3/30/2001
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 to 27 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1 to 16 is/are allowed.
- ☒ Claim(s) 17 to 23 and 25 to 27 is/are rejected.
- ☒ Claim(s) 24 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2875

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 18 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, the frame of reference for "front half portion" and "back half portion" is not clear. Which direction is considered to be the front half portion and which direction is considered to be the back half portion?

In claim 26, the frame of reference for adjacent area is not clear, adjacent area with respect to what reference?

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 17, 18, 20, 21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lichon et al.

Lichon et al. show a body member (figure 1, the nontransparent motorcycle gasoline tank) shaped as a motorcycle gasoline tank, an illumination member (10) associated with the body member, the body member defined by a front half portion (toward the seat) and a back half portion (toward the handles), the illumination member associated with the front half portion, and means (63, the circuits, power source of the motorcycle) for energizing the illumination member. Note that Lichon et al. also show that the illumination member may also use other lamp socket arrangement to increase the signaling capabilities (column 4, lines 9 to 12). The illumination member of Lichon et al. would therefore inherently perform the function of a turn signal.

4. Claims 17, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlson (prior art previously cited).

Art Unit: 2875

Carlson shows a body member (10) shaped as a motorcycle gasoline tank, an illumination member (44) associated with the body member, a portion (39) of the body member removed, at least a portion (figure 4, the very top of the illumination member) of the illumination member disposed in the portion of the body member, and means (column 2, line 50) for energizing the illumination member.

5. Claims 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lichon et al.

Lichon et al. show the steps of providing a body member (figure 1, the motorcycle gasoline tank) in the shape of a motorcycle gasoline tank, associating an illumination member (10) with the body member so that the illumination member illuminates surrounding area of the motorcycle to which the body member is attached, and providing means (63, the circuits, power source of the motorcycle) for energizing the illumination member.

6. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Carlson (prior art previously cited).

Carlson shows a body member (41) adapted for attachment to a motorcycle gasoline tank (10), an illumination member (44) attached to the body member to provide light to illuminate an adjacent area.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al.

Lichon et al. disclose the invention substantially as claimed with the exception of having the step of associating the illumination member with a front half portion, which is closest to a front area of the motorcycle, of the body member.

Art Unit: 2875

Note that associating the illumination with a front half portion of the body member would have been an obvious matter of design choice and preference which provides no unusual, unobvious and/or unexpected result and is therefore deemed to fall within a purview of an ordinary engineering design technique to associate the illumination member with any portion of the body member depending upon where the illumination is deemed necessary to transmit a warning signal.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al. in view of Helm (prior art previously cited).

Lichon et al. disclose a motorcycle gasoline tank (figure 1). However, Lichon et al. do not disclose an illumination member attached to a body member adapted for attachment to the gasoline tank.

Helm discloses a body member (17, 21) adapted for attachment to a gasoline tank, an illumination member (12 to 16) attached to the body member to provide light to illuminate the adjacent area.

Since Lichon et al. and Helm are both from the same field of endeavor, the purpose disclosed by Helm would have been recognized in the art of Lichon et al.

It would have therefore been obvious to one skilled in the art to provide the gasoline tank of Lichon et al. with a body member having the illumination member attached thereto, as shown by Helm, for providing light to illuminate the adjacent area.

10. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Quach Lee whose telephone number is (703) 308-1939. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding

Serial Number: 09/323,636

Page 5

Art Unit: 2875

should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Y. Q.
June 28, 2001



Y. Quach Lee
Patent Examiner
Art Unit 2875